



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Re the Application of:

Baker

Serial No.: 09/061,017

Filed: April 15, 1998

For: METHOD AND APPARATUS FOR
INTERLEAVING A DATA STREAM

Art Unit: 2732

Examiner: D. Vincent

Honorable Director of
Patents and Trademarks
Washington, D.C. 20231

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SUPPLEMENTAL APPEAL BRIEF UNDER 37 C.F.R. § 1.193(b)(ii)(2)
IN SUPPORT OF APPELLANT'S APPEAL
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

Dear Sir:

Pursuant to 37 C.F.R. §193(b)(2)(ii), Appellant hereby reinstates the Appeal of the above referenced patent application ("application") and submits this Supplemental Appeal Brief in response to the Final Office Action ("Final Action") for reopened prosecution, dated February 12, 2001.

Claims 1-19 are the subject of the appeal. The Examiner has maintained his rejection of all claims. Claims 1-3, 6-9 and 11-19 stand rejected under U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,291,485 by Afify et al. ("Afify"). Claims 4, 5 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Afify as applied to claim 1, and further in view U.S. Patent No. 5,825,772 by Dobbins et al. ("Dobbins").

All arguments in Appellant's Appeal Brief ("Appeal Brief"), filed January 28, 2000, and Appellant's Reply Brief ("Reply Brief"), filed May 19, 2000, are herein incorporated into this Supplemental Appeal Brief.

It is noted that an inadvertent grammatical error was noted in the Appeal Brief. The first line of the second indented section on page 8 of the brief states, "As illustrated in FIG. 1, the read **right pointers of FIFO 11...**" (*emphasis supplied*) This should, however, state "As illustrated in FIG. 1, the read **and write pointers of FIFO 110...**" (*emphasis supplied*)

Appellant respectfully submits this correction merely goes to matters of form and respectfully

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requests that the Board consider this minor modification in considering Appellant's appeal on the application.

The Examiner has reopened prosecution, asserting that "prosecution [was] reopened to reply to an argument that was not raised in the Appeal Brief, the Amendment, nor the After Final Amendment" and that "Applicant did not challenge the Examiner's taking of office notice." In this regard the Examiner cites In re Chevnenard, 60 USPQ 239 (CCPA 1943) and MPEP § 2144.03. The Examiner then goes on to address an argument Applicant made in the Amendment, mailed on August 6, 1999, with respect to a term of which Official Notice was taken. Applicant respectfully notes the Examiner did not address this argument of the Applicant's until filing an improper substantive response to Applicant's Reply Brief, which merely asserted that the Examiner's characterization should be afforded no weight in consideration of the appeal, as he had failed to comply with MPEP § 2144.03. Applicant respectfully asserts that the foregoing assertions of the Examiner are unfounded based on the cited authorities and by his own arguments with regard to Appellant's amendment of August 6, 1999.

With respect to In re Chevenard, it appears that the Examiner feels that case stands for the proposition that form over substance is expected by the courts with respect to challenging any taking of official notice by an examiner. Appellant respectfully asserts that such a technical condition is not required by the cited case. In this respect, Judge Jackson specifically states at page 241:

The appellant in his brief states that the examiner cited nothing to support his holding...and insists that the examiner's assertions do not coincide with the actual facts. **In the absence of anything in the record to contradict the examiner's holding, and in the absence of any demand by the appellant for the examiner to produce authority for his statement, we will not consider this contention.** (*Emphasis supplied*)

In this case, the court would not consider the argument proffered by the appellant in his brief because he neither **challenged the assertion nor demanded authority during prosecution on the merits**. Furthermore, the court in no way imposes a form requirement that an applicant must employ any specific language in challenging Official Notice, contrary to the apparent assertion of the Examiner that such specific language is required. The court, instead, is looking for "**anything in the record to contradict the examiner's holding.**" By the Examiner's own arguments in the Final Action (*See page 2*), it is clear that **Appellant did in fact contradict the Examiner's holding on the record in the Amendment**. Specifically, on page 3, third full paragraph of Appellant's response mailed on August 6, 1999, Appellant stated that "[a]lthough it is true that the amount of information to be transferred via a burst or burst mode, in terms of bits or bytes, for example, may vary, nonetheless, **contrary to the Examiner's position, usually,**

in this context, the information is transferred in fixed or predetermined chunks. The Examiner did not address Appellant's contradiction on the record, but subsequently raised the same characterization of the term at issue, specifically "burst", in the Examiner's Answer, dated March 21, 2000, to which Appellant properly replied to in the Reply Brief. (See pages 1-2)

The Examiner has also relied on MPEP §2144.03 in support of his position regarding a challenge of official notice. Again, Appellant respectfully asserts that the Examiner's position as to what that section requires is overly technical and clearly inaccurate. The relevant portion of that section recites:

If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, applicant is charged with rebutting the well known statement in the next reply after the Office action in which the well known statement was made.

Contrary to the Examiner's position that an applicant must use precise language that the official notice is traversed, MPEP § 2144.03 clearly requires that applicant rebut the well-known statement, which Appellant clearly did, even by the Examiner's own arguments. This requirement is so "the examiner [is] given the opportunity to provide evidence in the next Office action or explain why no evidence is required." The Examiner, in this case, did neither of these until his improper substantive answer to Appellant's Reply Brief. Based on the foregoing, Appellant, once again, respectfully asserts that the Examiner's characterization of the term "burst(s)" should be afforded no weight, as Applicant complied with the requirements of MPEP § 2144.04 and In re Chevenard, while the Examiner did not meet his burden regarding his Official Notice during prosecution on the merits.

Even were the board to conclude that the Examiner's position regarding the technical requirement regarding a challenge of official notice were proper, which, of course is not conceded, the Examiner's position would still be unavailing. It is a well-settled principle that patentees are free to be their own lexicographers. Here, Appellant is free to define "burst" in a manner consistent with the invention, notwithstanding any common or well-known meanings of that term. Therefore, the fact that Appellant states that "contrary to the Examiner's assertion, usually, in this context, the information is transferred in fixed or predetermined chunks", should be, in and of itself, sufficient to overcome the Examiner's characterization of that term.

The Examiner also makes two additional assertions as to Appellant's position regarding this matter, which will now be addressed. The first assertion is "applicant clearly conceded to the point that the term burst was well known but did not like the way it was characterized."

Based on the foregoing, it is clear that Appellant in no way made any such concession.

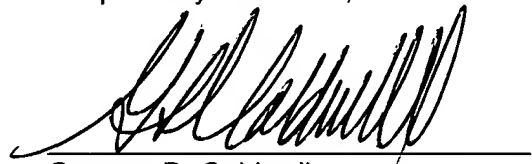
Appellant merely acknowledged that the Examiner's characterization of the term was one possible construction of that term. Appellant's further statements clearly indicate that the construction put forth by the Examiner was not consistent with the context of the invention, as claimed.

The second assertion by the Examiner is "...now the applicant is not going to argue the term was not characterize appropriately, because now the applicant only wants to see the term existed." Appellant again respectfully disagrees with this statement by the Examiner. Based on the foregoing, it should be clear that Appellant does not agree with the Examiner's characterization of the term, at least in context of the application, nor has any concession as to what Appellant will argue been made.

Appellant respectfully requests reinstatement of the appeal, that the Board give no weight to the Examiner's taking of official notice regarding the term bursts, and that that the board direct allowance of all claims pending in the application.

Respectfully submitted,

Date: 4/30/01


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